



**UNITED STATES DEPARTMENT OF COMMERCE**  
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*T.D.*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/624,246	07/24/00	CLARKE	P 1131-0444P

IM52/1004  
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EXAMINER

LOPEZ, C

ART UNIT PAPER NUMBER

1731

*5*

DATE MAILED: 10/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/624,246

Applicant(s)

CLARKE ET AL.

Examiner

Carlos Lopez

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/24/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to because elements 12 and 24 in figure 17 are not clearly depicted from each other. Correction is required.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Element 48 in Fig. 18. Correction is required.

### ***Claim Rejections - 35 USC § 112***

1) Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17- 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2) Claims 1, 4-12, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Newsome et al (US 5,178,166). Newsome discloses a filter for a cigarette comprising

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a cylindrical filtering core (24); a tubular filtering sheath (26) surrounding said core and between said core and sheath, passages spaced circumferentially around said core and extending continuously between the two open ends of the filter (Figure 1). As for claim 4, Newsome discloses means for introducing air (32) into said passages through said sheath (Figure 1). As for claims 5 and 8, the core has a plurality of longitudinal grooves at the outer peripheral surface thereof, defining said passages with the inner peripheral surface of said sheath (Figure 1). As for claim 6 and 9, said grooves are provided by a corrugated wrapper (30) (Figure 1). As for claim 7 and 10, both the inner and outer peripheral surfaces of said sheath have inherent air permeability to allow the passage of air being introduced by means 32 as shown in figure 1. As for claim 11, the cylindrical wrapper (30) is arranged between said core and sheath (Figure 1). As for claim 12, tubular element (30) is arranged between said core and said sheath and having passages therein (Figure 1). As for claim 16, the claimed filter is connected to a cigarette having a tipping paper with air permeability holes 38 (Figure 1). As disclosed above Newsome clearly anticipates the above claims.

3) Claims 1, 4-10, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Morifuji et al (US 4,488,563). Morifuji discloses a filter for a cigarette comprising a cylindrical filtering core (2); a tubular filtering sheath (7) surrounding said core and between said core and sheath, passages spaced circumferentially around said core and extending continuously between the two open ends of the filter (Figure 1). As for claim 4, Newsome discloses means for introducing air (5) into said passages through said sheath (Figure 1). As for claims 5 and 8, the core has a plurality of

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longitudinal grooves at the outer peripheral surface thereof, defining said passages with the inner peripheral surface of said sheath (Figure 1). As for claim 6 and 9, said grooves are provided by a corrugated wrapper (4) (Figure 1). As for claim 7 and 10, both the inner and outer peripheral surfaces of said sheath have inherent air permeability to allow the passage of air being introduced by means 5 as shown in figure 1. As for claim 16, the claimed filter is connected to a cigarette having a tipping paper with air permeability holes 38 (Figure 1). Additionally, Morifuji attaches said filter to a cylindrical tip element having applicant's limitations of claim 15. reciting length of 2-20mm, air flow resistance of 80mmH<sub>2</sub>O/25mm and having a 8 to 60% overall length of said filter. Morifuji anticipated the above claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 2, 3, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morifuji et al (US 4,488,563). As disclosed above, Morifuji anticipates claim 1 from which claims 2,3 and 14 are dependant on. Morifuji is silent in disclosing the thickness of said sheath, the ratio of the sheath thickness to the diameter of the core and the total cross-sectional area of the passages. However, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the thickness

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of the sheath, the ratio of the sheath thickness to the diameter of the core and the total cross-sectional area of the passages in Morifuji's filter in order to achieve desired ventilation and desired removal efficiency.

***Allowable Subject Matter***

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The claim limitation of perforating the corrugated material forming the tubular passages at the outer peripheral surface of the core ("tubular element in communication with said passages") is not reasonably suggested or taught by the cited art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 703 605-1174. The examiner can normally be reached on 8am - 5pm.

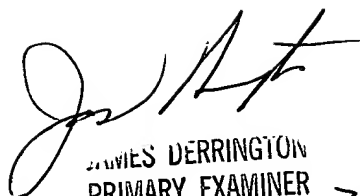
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 703 308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-7718 for regular communications and 703 305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.

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C.L  
October 1, 2001

  
JAMES DERRINGTON  
PRIMARY EXAMINER  
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